UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/527,546	03/16/2000	Michael J. Conrad	202812	2335

23460	7590	12/30/2003

LEYDIG VOIT & MAYER, LTD
TWO PRUDENTIAL PLAZA, SUITE 4900
180 NORTH STETSON AVENUE
CHICAGO, IL 60601-6780

EXAMINER
PARTON, KEVIN S

ART UNIT	PAPER NUMBER
2153	8

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/527,546	Applicant(s) CONRAD ET AL.
	Examiner Kevin Parton	Art Unit 2153	

Advisory Action

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may <u>only</u> be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

     NOTE: *See Continuation Sheet*.

3.☐ Applicant's reply has overcome the following rejection(s): _____.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☐ The a)☐ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

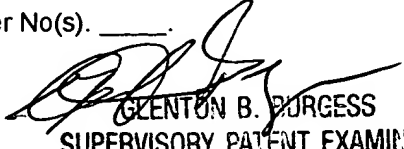   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-19*.

   Claim(s) withdrawn from consideration: _____.

8.☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10.☐ Other: _____

GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Continuation of 2. NOTE: The amendment requires further search and consideration because it specifically points out in the independent claims that the reporting client has both a client module and a plug-in module which was not required as previously claimed. Further, the newly amended claims require that only the client module (separate from the plug-in) communicate with the reporting server. This new limitation requires further consideration and/or search.

Th applicant's arguments accompanying the after final amendment have been considered but are not persuasive. Specifically, the applicant argues that "the Final Action appeared to be asserting that the term 'plug-in' in the claims is to be ignored" (page 8, paragraph 2). The argument is not persuasive because the term plug-in is clearly not ignored in the previous rejection, it is included explicitly in the rejected claims as shown. The response to arguments in the previous rejection points out that the term plug-in does not have a universally accepted definition and that the programs of the reference read on the claim. The term plug-in should be more clearly pointed out in the claim if a specific definition is to be considered. Even if the definition of the term as stated in the applicant's arguments is accepted ("an auxiliary program that works with a major software package to enhance its capability"), the reference of Desai et al. (USPN 5,781,703) would still read on the claim. The IRAs of Desai et al. (USPN 5,781,703) are auxiliary programs that work alongside the computer's OS (major software package) and enhance its capability by allowing it to track performance metrics. In this sense, the reference ot Desai et al. (USPN 5,781,703) reads on the claimed "plug-in" even when the term is read to the definition of the applicant. Desai discloses all of the limitations of the claims as shown in the previous rejection.

The applicant further argues "it remains that the Desai et al. (USPN 5,781,703) reference has no teaching regarding "registering" performance metrics..." (page 9, paargraph 1). The argument is not persuasive because as shown in the previous rejection, the performance metrics are registered to the IRA which is located on the client as a "plug-in". The "plug-in" is used to register metrics with the client. The performance metrics are then measured.

Applicant's further argue that the current amendment "do not change the nature of the claims, and as a result no new search...would be necessary" (page 9, paragraph 2). The argument is not persuasive because, as the applicant points out, the limitation that there exists a client module and plug-in module has not been considered in previous rejections. Further, the newly amended claims require that only the client module (separate from the plug-in) communicate with the reporting server.